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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,588	02/09/2001	Richard Levy	01064.0011-07000	6816

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,588

Applicant(s)

LEVY, RICHARD

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/25/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the appeal brief filed February 25, 2004 and the Information Disclosure Statement filed April 2, 2004. Applicant's arguments are persuasive with respect to the 103 rejection over Geursen (WO9318233) combined with the admitted prior art in view of Hopkins.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 61-68 and 73-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 61, 62, 73 and 74 (and their dependent claims 63-68 and 75-85) lack support from the originally filed specification and claims for the limitations "substrate comprises a cable" (claims 61, 63, 65-68 and claims 73, 75 and 77-85) and "substrate comprises a wire" (claims 62 and 64-68 and claims 74 and 76-85).

Applicant argues that the specification supports these expressions "expressly, implicitly, or inherently." Applicant argues that pages 6-9 provide for lubricants, that page 12 provides for lubricants on cables, page 6 provides for lubricants on

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wires and that page 20 makes clear that the invention inter alia comprises the application of a "coating" of the disclosed superabsorbent polymer-lubricant composition to a substrate as well as the article of manufacture obtained. Page 20 also describes applicant's use of related prior art lubricants specified at pages 6-19 in the superabsorbent polymer-lubricant composition.

A careful study and review of the instant specification indicate that the particularly selected descriptions at pages 6-9 and 12, is admitted prior art under the section of the background of the specification as to what is well-known and conventionally used in the lubricant art. The present invention is clearly directed to the lubricant composition. If Applicant had intended to use the composition to coat cables and wires, there would be some mention of these articles in the summary of the invention and perhaps the examples. However, the examiner does not find such recitations. The term "cables" only appears once in the entire 75 page specification and is referring to a polyisobutylene lubricants applied to cables. The term "wire" appears 11 times, once referring to solid lubricants and the other 10 times to the mixer used to prepare the composition.

3. Claims 67, 68, 79 and 80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The specification does not support a coating composition comprising a super absorbent polymer, a lubricant and optional lubricant additives wherein the additive is a binder. Applicant states that "there is a need for additional materials that will provide the same advantage as those of the related as well as additional advantages and also materials that will overcome some of the various disadvantages of the related art. Nowhere in this recitation and any which precedes or follows it is there a recitation of combining a binder with the polymer and lubricant. The specification speaks to overcoming the disadvantages of the prior art and not to combining the prior art binders with the present invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 57 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Geursen et al (Geursen) WO9318233.

Geursen teaches a coated substrate that is coated with a composition comprising a superabsorbent polymer in an oil-in-water emulsion, where the liquid constituents of the emulsion are wholly or partially removed from the substrate (see abstract). This teaching sets forth that the coating of Geursen may be "substantially anhydrous". Geursen's composition comprises a lubricant and additive of the kind contemplated by

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applicant (see page 7, lines 20-28; page 8, lines 6-11). The substrate is a fiber (see abstract).

Accordingly, Geursen teaching all the limitations of the claims, anticipates the claims.

Applicant argues that Geursen's aqueous polymerization of the monomer into a superabsorbent polymer results in a polymer that absorbs about 45 or 20 times its weight in water. Applicant argues that Geursen contains examples showing that only low water absorbing superabsorbent polymers are produced and desires using them and not superabsorbent polymers that absorb greater than about 100 times their weight in water. Applicant argues that Geursen teaches away from the use of superabsorbent polymers that absorb greater than about 100 times their weight in water, and also lacks an enabling disclosure as to how to produce oil in water emulsions of superabsorbent polymers that absorb greater than about 100 times their weight in water.

The rejected claims do not contain the limitation regarding the amount of water that the polymers absorb. Therefore, applicant's arguments are moot.

6. Claims 57, 59, 61-69, 71 and 73-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 5,218,011).

Freeman teaches a gel composition comprising a gel matrix, a thickener (soaps) and a water absorbent polymer (see abstract). The gel matrix may be silicones, petroleum gels, high viscosity esters (fatty oils), glycol, olefins, mineral oil and fluorocarbons (see col. 7, lines 19-39). The water absorbent polymers include

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polyacrylic, maleic acids, acrylates, acrylamide and acrylonitrile (see col. 5, lines 55-68; col. 6, lines 1-29). The gel composition also contains a rust inhibitor (see col. 9, lines 26-35).

The gel composition is used to protect enclosed components or contents from water damage, such as cables and wires (see abstract; col. 3, line 65 through col. 4, lines 1-8). The thickeners are used to achieve a desired viscosity (see col. 8, lines 1-57). The gel composition also contains a tackifier or binding agent which helps bind the gel composition to the wire or cable (see col. 8, line 58 through col. 9, lines 1-25).

Accordingly, Freeman teaching all the limitations of the claims, anticipates the claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 58, 60, 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 5,218,011) in view of Le-Khac (US 4616,063).

Freeman has been discussed above. Freeman does not specifically teach that the super absorbent polymers of his invention absorb greater than 100 times its weight in water and desorb water when the coating is dried. In Example 22, Freeman teaches a composition comprising white oil (petroleum oil), micro-crystalline wax and a water

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absorbent polymer that is of the type described in 4,616,063 (Le-Khac). Le-Khac teaches that the polymers of his invention have a water up take up to 16,000% (see Table, col. 6).

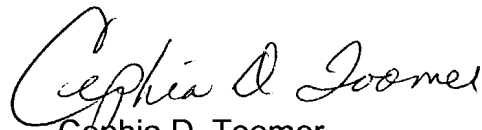
It would have been obvious to one of ordinary skill in the art to have used a polymer that absorbs greater than 100 times its weight in water because Le-Khac teaches that the polymers of Freeman have this capability. Freeman does not specifically teach that the polymers desorb water when the coating is dried; however, it would be reasonable to expect that polymers taught in Freeman would meet this limitation given that they are the same polymers or similar polymers as those of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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